

### **REMARKS**

Reconsideration and allowance of the subject application are respectfully requested. By this Amendment, Applicant has cancelled claims 145 and 147. Therefore, upon entry of this Amendment, claims 1-15, 17, 18, 20, 21, 23, 28, 32, 34-36, 39, 40, 51-53, 63, 65, 70-73, 76-78, 92, 106, and 144 and 146 are all the claims pending in the application. In response to the Office Action, Applicant respectfully submits that the claims define patentable subject matter.

#### **I. Overview of the Office Action**

Claims 145 and 147 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claims 51-53, 63, 65, 70-73, 76-78, 92, 106, 144-147 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Russo (U.S. Patent No. 5,619,247) in view of Hoshen et. al. (U.S. Patent Application Publication No. 2002/0154892, hereafter "Hoshen"). Claims 1-15, 17, 18, 20, 21, 23, 28, 32, 34-36, 39, 40 are allowed. Applicant respectfully traverses the prior art rejections.

#### **II. Objection to the Specification**

The Examiner has objected to specification as allegedly failing to provide antecedent basis for claimed subject matter. Specifically, the Examiner asserts that "[c]laims 144 and 146 claim computer readable medium which is not defined in the specification".<sup>2</sup> Applicant respectfully disagrees with the Examiner's position.

Page 62, lines 1-8 of the original specification discloses the "code may be stored in compiled format, in uncompiled format or in any format intermediate the two. The software may be provided on a carrier such as a CD-ROM or the like". Accordingly, Applicant respectfully

---

<sup>2</sup> Page 2 of the Office Action

submits that there is clear antecedent basis for the claimed "computer readable medium".

Therefore, the Examiner is requested to remove the objection to the specification.

### **III. Rejection Under 35 U.S.C. § 101**

The Examiner has rejected claims 145 and 147 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. By this Amendment, Applicant has cancelled claims 145 and 147, thus rendering moot the § 101 rejection.

### **IV. Prior Art Rejections**

#### **Disclosure of Russo**

Russo generally relates to a pay-per-play system which includes a high capacity storage medium that facilitates the compilation of video audio and other programs at the subscriber's site. The recording of program materials may be directed automatically by subscriber-operated storage management facilities which scan program schedules and select materials to be recorded based on title, cast or other viewer preferences (the Abstract). The program provider may automatically download programs based on actual or surmised viewer preferences or at the provider's discretion (the Abstract).

#### **Disclosure of Hoshen**

Hoshen generally relates to a method for distributing content over a cable network in which the subscribers are connected to a central unit in a hierarchical order of nodes, each node comprising a plurality of subscriber clusters. Some of the subscribers within each cluster are provided with a set-top box (STB) and the rest of the subscribers are provided with a storage STB (SSTB). Titles are transmitted from the central unit to the SSTB and stored within the SSTB. A viewable list of the titles stored in all of the SSTBs that are connected within the cluster of that subscriber is provided to each STB subscriber or SSTB subscriber. Whenever a

subscriber selects a title for viewing from the list, the selected title is transmitted to the STB or the SSTB of that subscriber from at least one of the SSTBs within the cluster of that subscriber (the Abstract).

### **Analysis**

The Examiner asserts that Russo teaches all of the elements of independent claim 51 and analogous independent claims 70 and 106 except for a playout unit operable to playout the contents stored on the storage device only in response to receiving a remote transmission indicating permission to playout the contents; whereby the user device initiates server side capture of the content, provides client side storage of the captured content, and initiates playout of the captured content under server side control, as recited in independent claim 51 and analogously recited in claims 70 and 106. The Examiner thus relies on Hoshen to allegedly remedy this conceded deficiency. Applicant respectfully disagrees with the Examiner.

First, Applicant respectfully submits that there is no teaching or suggestion in Russo of “a transmitter operable to transmit, in response to a first user input identifying content to be recorded, a request to a remote capture system to capture the content identified by said first user input”, as recited in claim 1 and analogously recited in claims 70 and 106.

The Examiner cites column 3, lines 60-64 of Russo as allegedly teaching this aspect of the claims. However, this cited portion of Russo teaches that a communication link may be provided for interacting with “, as recited in claim 1 and analogously recited in claims 70 and 106.

The Examiner cites column 3, lines 60-64 of Russo as allegedly teaching this aspect of the claims. However, this cited portion of Russo teaches that a communication link may be provided for interacting with the cable system billing or ordering facilities. Applicant

respectfully submits that this has no relevance to the claimed invention. Additionally, Russo appears to teach that the data is captured by a VCR (6) at the subscriber side (see column 3, lines 46-57), and not at a remote server as required by the claims.

This aspect of the claimed invention allows the server-side access and capture of audio/video data. A user may indicate or create a list of programs to be broadcast or programs currently being broadcast which the user wishes to record. The programs are then captured during broadcast of the programs or the capture device looks ahead for all programs that are to be recorded which are due to start or end within a specified period and then generates the appropriate instructions to enable capture and recording of the requested program (see for example, page 19 of the original specification). Accordingly, the requested programs are remotely captured during their broadcast.

Further, Applicant respectfully submits that there is no teaching or suggestion in Hoshen of “whereby the user device initiates server side capture of the content”, as recited in claim 50 and analogously recited in claims 70 and 106.

The Examiner cites paragraphs [0021] and [0067] of Hoshen as allegedly teaching this aspect of the claims. However, these cited portions of Hoshen teach that the data is captured at the set-top box and not at the remote server as required by the claims. Hoshen teaches that upon receiving a request to view a title, the Management System 57 locates two SSTBs residing in the same cluster as the requesting subscriber's STB, and which contain the requested title in their storage. One of the SSTBs then streams the title to the requested subscriber. Accordingly, the data is not captured at the server side based on an initiation by a user device as required by the claims, but is transmitted and stored on the SSTB at the subscriber side and retrieved from the SSTB when requested by the user. This is clearly disclosed by Hoshen in paragraph [0070]

where it is taught that if a subscriber requests a DVR service for a specific program, selected SSTBs are instructed to record the selected program and store it.

Nowhere does Hosen teach or suggest “the user device initiates server side capture of the content”, as recited in claim 51 and analogously recited in claims 70 and 106.

Accordingly, Applicant respectfully submits that independent claims 51, 70 and 106 should be allowable because the cited references, alone or in combination, do not teach or suggest all of the features of the claims. Claims 52, 53, 63, 65, 145, 71-73, 76-78, 144, and 146 should also be allowable at least by virtue of their dependency on independent claims 51 and 70.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Mark E. Wallerson/

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 10, 2009

---

Mark E. Wallerson  
Registration No. 59,043